

**REMARKS**

**Claim Rejections under §102**

**Claims 1, 3-4, 7-10, 13**

The examiner rejects claims 1, 3-4, 7-10, and 13 under §102 over EP. Applicant requests reconsideration.

Independent claim 1 requires that the mobile station "normally provid[e] a basic channel report" and "selectively provid[e] an enhanced channel report... wherein said enhanced channel report provides a more detailed view of said downlink channel than said basic channel report." The examiner asserts that EP shows a basic channel report in the third embodiment and an enhanced channel report in the sixth embodiment. Applicant respectfully disagrees for two fundamental reasons. First, EP simply does not teach, in any manner whatsoever, that the mobile station is able to change between the third and the sixth embodiment. Instead, the EP mobile terminal operates according to the third embodiment or operates according to the sixth embodiment, period. As such, the EP mobile terminal simply does not, as the examiner suggests, switch between the two embodiments as required to meet the limitations of the claim. Simply put, there is absolutely no evidence that EP teaches switching a given mobile terminal between embodiments, nor is there any teaching as to how such a switch would be accomplished. As such, EP cannot form a proper basis for a §102 rejection of claim 1.

Applicant notes that the examiner seems to acknowledge this defect in the rejection when the examiner states "As to whether the reference contemplates whether one type of report is transmitted or two, it clearly indicates that multiple reports are transmitted periodically and in the sixth embodiment the reports are adjusted on the value of P and N as discussed in paragraph 64" (¶23 of Action). Whatever EP may teach about periodically sending reports, and thus generating "multiple reports," each embodiment contemplates that only type of report is sent, not two. Further, the discussion in ¶64 of EP with respect to P and N only relates to if a report is sent, not the type of report sent.<sup>1</sup> In other words, it is undisputed that the EP mobile terminal of the sixth embodiment sends only one type of report, not two different type of reports.

Second, Applicant notes that the examiner is factually incorrect with respect to the contents of the sixth embodiment's report. The examiner states that the sixth embodiment's report "includes a threshold value that limits the mobile terminals reporting..." (¶24 of Action). However, the sixth embodiment's report does not contain the threshold value; instead it appears

to contain only the CQI information and feedback indicator, just like the examiner's putative basic channel report of the third embodiment. The threshold value referred to by the examiner is transmitted by the base station, not the mobile terminal. Thus, it is not present in the report transmitted by the mobile terminal, as asserted by the examiner. In terms of the claim language of claim 1, this threshold value pointed to by the examiner would at best correspond to the claimed feedback criterion (albeit not necessarily a "common feedback criterion"). In short, it is not part of the enhanced channel report as claimed.

Third, Applicant again asserts that all the "quality reports" of EP contain the same information for characterizing the channel, the "quality information" as defined in ¶4 and ¶32. While the particular value reported in different reports may change in EP, the ability of the reported "quality information" to characterize the downlink channel, for a given embodiment in EP, does not change. Thus, regardless of whether one looks to the report of embodiment three or the report of embodiment six, the contents of the report are the same. Given that it is undisputed that the characterizing information contents are the same between the third and the sixth embodiment, Applicant must once again challenge the examiner to explain in detail how the sixth embodiment can possibly, much less necessarily, provide a more detailed view of the downlink channel as required by the claim. Applicant does note the examiner's explanation in ¶24 of the Action, but it is readily apparent that the examiner has miss-interpreted the teachings of EP. The EP reports contain the "quality information", which is the same parameter as used to establish the threshold. This is clear from ¶64, reading in relevant part, "the quality information of the mobile station having Nth reception quality from the best quality is set as the new threshold value P..." Thus, the EP report contains the very characteristic being used as the threshold. As such, the EP report has a fixed given ability to characterize the channel, regardless of whether the "threshold" value is present or not.<sup>2</sup> A fixed ability to characterize is not the claimed "enhanced channel report provid[ing] a more detailed view of the said downlink channel" as claimed.

With additional regard to dependent claim 10, this claim requires "wherein said basic channel report comprises information related to a first set of one or more channel parameters of said downlink channel, and wherein said enhanced channel report comprises further information

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<sup>1</sup> Applicant also notes that the discussion of P and N is with reference only to what is happening at the EP base station, not the mobile terminal. For example, there is no evidence that the EP mobile terminal ever sees the value N; instead, N is value used only internal to the EP base station.

<sup>2</sup> If the examiner disagrees, Applicant requests that the examiner list the precise contents of the sixth embodiment's report and the contents of the third embodiment's report, with citation to the EP passages supporting the examiner's position.

on said first set of channel parameters." In rejecting this claim, the Examiner has shifted his earlier stated rationale, and now points solely to ¶¶46-52, 61-69 of EP. Applicant respectfully submits that the cited passages of EP, with are merely the discussion of the third and sixth embodiments respectively, simply do not support the Examiner's assertion on this point. A reading of the cited paragraphs in EP finds no mention of any "basic" report regarding one set of channel parameters, and an "enhanced" report with "further information" on *that* set of channel parameters. Instead, the cited paragraphs appear to only mention a single type of "quality," which is defined in ¶4. Applicant does note that examiner, in ¶24 of the Action, indicates that the quality information transmission in the six embodiment contains the threshold value, and the quality information transmission in the third embodiment does not. This is both incorrect and insufficient. EP plainly states that threshold is transmitted from the base station to the mobile station, not from the mobile station to the base station. Therefore, there is no support for the notion that the threshold value is present in the transmission from the mobile terminal to the base station. Also, as pointed out above, even if the threshold value is present, it provides no more of a detailed view of the downlink channel than the purported "basic channel report." Other than this plainly unsupported assertion regarding the "threshold value," Applicant is unable to determine any place where the examiner identifies any element of the purported "enhanced channel report" that is not present in the purported "basic channel report." The examiner is therefore requested to clarify the examiner's position on this point. And, Applicant also respectfully reminds the examiner of the MPEP's mandate that "the Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal" MPEP §706.07. As such, Applicant requests that the Examiner set forth a specific listing of the channel parameters provided in EP's alleged "basic channel report," and to specifically identify the precise "further information" allegedly provided by EP depending on a threshold comparison, with specific pinpoint citations to the passages relied on in EP for support. The examiner is also requested to specifically identify where EP describes how the mobile station changes from operating according to the third embodiment to operating according to the sixth embodiment.

In view of the above, Applicant submits that the §102 rejection of independent claim 1, and its dependent claims 3-4, 7-10, and 13, is improper.

**Claims 21, 23-25, 28**

The Examiner rejects claims 21, 23-25 under §102 over EP. Applicant requests reconsideration for reasons similar to those discussed above with respect to claim 1. And, Applicant submits that the logic presented above with respect to dependent claim 10 also applies to dependent claim 25.

**Claims 35-37**

The Examiner rejects claims 35-37 under §102 over EP. Applicant requests reconsideration for reasons similar to those discussed above with respect to claim 1. And, Applicant submits that the logic presented above with respect to dependent claim 10 also applies to dependent claim 37.

**Claims 52-53, 55-56**

The Examiner rejects claims 52-53, 55-56 under §102 over EP. Applicant requests reconsideration for reasons similar to those discussed above with respect to claim 1.

**Claims 58-59, 61-62**

The Examiner rejects claims 58-59, 61-62 under §102 over EP. Applicant requests reconsideration for reasons similar to those discussed above with respect to claim 1.

**Claims 64, 66**

The Examiner rejects claims 64, 66 under §102 over EP. Applicant requests reconsideration for reasons similar to those discussed above with respect to claim 1.

**Claim Rejections under §103**

**Claims 14, 28**

The Examiner rejects claims 14, 28, and 33 under §103 over EP alone. Applicant requests reconsideration. First, Applicant cannot agree that "any form of communication between the mobile terminal and the base station" necessary satisfies the claim limitations regarding "implicit" and "explicit" indications. Attention is directed to the discussion *infra* regarding the §112 rejections for further discussion on this point. Second, Applicant notes that while EP may use the UL HS-DPCCH and UL DPCCH channels in transmitting its quality information, there is simply no indication in EP that EP uses these to distinguish between which

type of report is being sent. Thus, assuming *arguendo* that EP teaches flagging when quality information is being sent, it does not indicate to the base station which type of quality report is being sent -- basic or enhanced. The reason for this is simple -- EP contemplates that only one type of channel report will be used with each embodiment, not that two different types of reports will be used by the same embodiment. Thus, claims 14, 28 define over EP.

#### Claims 19, 33

The Examiner rejects claims 19, 33 under §103 over EP alone. Applicant requests reconsideration. Applicant notes that the examiner appears to consider that any combination of transmissions from the mobile station occurring at a different time satisfies the limitation for being on a different logical channel. In support of this, Applicant points to the examiner's statement "... then the mobile stations would send the enhanced channel report on a second logical channel as the enhanced channel report would occur at a later time." However, one of skill in the art does not consider a mere temporal separation of transmission time to necessarily mean a separate logical channel. Instead, one of skill in the art would recognize that transmissions on the same logical channel may occur at different points in time. In view of the above, Applicant requests that the examiner clarify the basis for this rejection or withdraw the rejection as improper.

#### Claims 2, 5-6, 11-12

The Examiner rejects claims 2, 5-6, 11-12 under §103 over EP in combination with WO 00/70897 ("WO"). Applicant requests reconsideration.

With respect to these claims, Applicant repeats the arguments previously presented. Further, Applicant notes that while a base station may transmit to a plurality of mobile stations on a mobile-station-by-mobile-station basis, such are not a "broadcast" transmission as that term is understood by one of skill in the art. The examiner is specifically requested to acknowledge or deny this; and, if denied, to provide a factual basis for the examiner's position regarding how the term "broadcast" would be understood by one of skill in this art. Applicant also notes that the examiner's reliance on WO is solely for "the teaching of event-based reporting by a mobile terminal based on a specific triggering measurement event or other information sent from a control node." However, Applicant submits that EP already teaches has event-based reporting by a mobile terminal based on a specific triggering measurement event (surpassing the threshold P, set by base station, in the sixth embodiment). Thus, the examiner

purports to add WO for a reason that is already met by EP. Clearly, such a purported motivation to combine is improper.

Claims 22, 26-27, 38-39, 54, 60, and 65

The Examiner rejects claims 22, 26-27, 38-39, 54, 60, and 65 under §103 over EP combined with WO. Applicant requests reconsideration for reasons similar to those discussed above with respect to dependent claims 2, 5-6, 11-12 and previously presented.

Claims 16-17, 30-31

The Examiner rejects claims 16-17, 30-31 under §103 over EP combined with Seo. Applicant requests reconsideration.

For claims 16 and 30, Applicant submits that EP does not make the showings necessary to support the rejection as discussed above with respect to claim 1. Further, Applicant notes that the examiner's rejection explicitly relies on the proposition that "Seo teaches in Figure 9 one way of using a spreading factor to indicate the presence of specific information related to CQI. See Figure 9 and paragraphs 116-119" Seo makes no such showing. The cited portions of Seo do *mention* using a scrambling code, and also *mentions* CQ information. However, there is no teaching in Seo that any scrambling code is used to indicate that the CQ information is present or not. Instead, the scrambling code appears to be used merely for the conventional purpose of a scrambling code. In short, the selection of one scrambling code over another in Seo does absolutely nothing to indicate to the base station whether a CQ value is present or not. Given this, it necessarily follows that Seo does not use different scrambling codes to distinguish between types of channel reports, as claimed. And, it is undisputed that EP likewise does not. Accordingly, the §103 rejection of claims 16 and 30 is improper because the combination of cited art, assuming such combination is proper, does not teach or suggest each limitation.

Similar logic applies to the rejection of claims 17 and 31. Simply put, just because pilot information is used somehow in transmitting to the base station, this does not teach or suggest using different pilot patterns to indicate which type of channel report is being transmitted. Accordingly, the §103 rejection of claims 17 and 31 is improper.

Claims 57, 63, and 67

The Examiner rejects claims 57, 63, and 67 under §103 over EP combined with Baker. Applicant requests reconsideration.

First, Applicant submits that EP does not make the showings relied on by the examiner for these rejections, for the reasons discussed above. Second, Applicant notes that the examiner relies on Baker for the teachings related to amount of data queued at the base station. On this point, Applicant will assume *arguendo* that Baker teaches a scheduler that considers the amount of data queued at a base station, on a mobile-station-by-mobile-station basis, for determining which mobile station to transmit to. However, simply because a base station scheduler considers data queue amount does not mean that the base station, when setting the channel reporting threshold, should or will consider the data queue amount. Indeed, Applicant notes that EP uses a fixed predetermined value of N that does not change in setting the channel reporting threshold. See EP ¶65. Nothing in EP suggests that N should be varied based on an amount of data queued, or any other parameter. And, nothing in Baker suggests the presence of any control over the amount of mobile stations reporting channel quality, much less the type of channel reports. Thus, nothing in either document suggests the change proffered by the examiner. Accordingly, Applicant submits that the examiner is using hindsight reconstruction to combine EP and Baker, and that such combination is improper.

Claim Rejections under §101

The examiner rejects claims 35-39 under §101 as claiming multiple classes of statutory subject matter. Applicant notes that claim 35 is directed to "a computer readable medium comprising a computer readable program embodied therein for a wireless communication mobile terminal... the computer readable program comprising ... computer readable program code that normally causes said transmitter to ..." Applicant respectfully submits that the claim is directed to statutory subject matter. Applicant notes, for example, claim 16 of recently issued U.S. Patent No. 7,032,171 is directed to "a computer readable medium having computer readable program code embodied therein for selecting ... the computer readable program code in the computer readable medium comprising: computer readable program code for causing a computer to ..." Applicant respectfully challenges the examiner to explain how such a claim is directed to §101 statutory subject matter, while claim 35 is not. Applicant further requests the examiner to provide the legal citation for the examiner's proposition that "under 35 U.S.C. 101 a single statutory class of subject matter must be claimed." Finally, Applicant directs the

examiner's attention to the current version of the MPEP §2106 IV.B. (page 2100-11) which directs that "If the invention as set forth in the written description is statutory, but the claims define subject matter that is not ... Office personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim." Applicant notes that no such indication of statutory subject matter has been provided. Similar logic applies to claims 64-67.

In view of the above, Applicant submits that claims 35-39 and 64-67 are directed to statutory subject matter under §101, and the examiner has failed to present a prima facie case to the contrary. And, if the claims are not directed to statutory subject matter under §101, Applicant asks the examiner to comply with the MPEP's direction to "identify the features of the invention that would render the claimed subject matter statutory if recited in the claim."

#### **Claim Rejections under §112**

The examiner rejects claims 35-39 under §112 as allegedly reciting "multiple yet distinct inventions." Apparently, the two "inventions" of the examiner are the "computer readable medium" and the "computer readable program." If this is not correct, the examiner is requested to clarify the rejection by explicitly stating what the two putative "inventions" are. Assuming that the "inventions" are the "computer readable medium" and the "computer readable program," Applicant requests that the examiner explain how claim 16 of recently issued U.S. Patent No. 7,032,171 is acceptable, while claim 35 is not. If the examiner feels that changing "computer readable program" in the preamble to read "computer readable program code" would resolve the issue, Applicant is willing to make such change. Applicant also directs the examiner's attention to MPEP §2106 IV.B.1(a) (page 2100-13 of the current MPEP), which reads in relevant part "In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." Applicant submits that the computer readable medium encoded with the claimed program meets this test. Similar logic applies to claims 64-67. In view of the foregoing, Applicant submits that claims 35-39 and 64-67 satisfy §112 ¶2.

The examiner rejects claims 14 and 28 under §112, ¶2 for the use of the term "explicit indication." The examiner asserts that with respect to "explicit indication" "it is unclear how one would explicitly indicate the presence of the enhanced channel report." Attention is directed to



¶¶22-23 of the specification, which read in part "The mobile terminal 30 may either explicitly or implicitly signal whether the channel report being transmitted to the base station 14 is a basic channel report or an enhanced channel report. For instance, the mobile terminal 30 may use an explicit signal, such as the Transmit Format Combination Indicator (TFCI) 316 (see Figure 3), or may use an implicit signaling approach of using a different pilot pattern 314 (see Figure 4) when sending an enhanced channel report." And, ¶23 of the specification goes into greater detail concerning this. Thus, the specification describes "how one would explicitly indicate the presence of the enhanced channel report." Applicant also notes that claim 11 of U.S. Patent No. 6,731,932 uses the term "explicit indication" in a similar fashion; and that the '932 patent appears to be in same general technical field. In view of the above, Applicant submits that the term "explicit indication" would be understood by one of skill in the art, and therefore claims 14 and 28 meet the requirements of §112, ¶2.

The examiner rejects claims 15 and 29 under §112, ¶2 for the use of the term "implicit indication." These claims have been canceled, rendering discussion thereof moot.

The examiner rejects claims 16-17 and 30-31 under §112, ¶2 for use of the term "different." These claims have been amended to address this concern without narrowing the scope thereof or introducing new matter.

### **Drawings**

The examiner again objects to Figures 1 & 8, suggesting that they show only the prior art. In making the objection, the examiner appears to place great weight on that fact that ¶14 of the specification describes the transmissions from the base station as being targeted or broadcast. The statement regarding "known to those of skill in the art" is made in ¶14 with regard to the meaning of "targeted" and "broadcast," and does not imply that base station 14 is known, in its entirety, in the prior art.

Applicant admits that part of the functioning of the base station 14 in Figures 1 and 8 is known in the prior art. For instance, the functionality for making downlink communications of user data, in general and distinct from the reporting of channel reports, is known. However, not all the functioning of the base station 14 in Figures 1 and 8 is known in the prior art; specifically, that part being claimed regarding control over the channel reporting as claimed is not known. Thus, base station 14 is a hybrid of known and new functionality. Therefore, as a whole, the base station 14 is a new type of base station not found in the prior art, with functionality not

found in the prior art. As such, labeling Figures 1 and 8 as "prior art" would be incorrect, as they contain a novel base station.

Accordingly, neither Figure 1 nor Figure 8 are wholly limited to prior art, and these figures should therefore not be labeled as prior art. In view of this, Applicant respectfully requests the examiner to withdraw the objection to the drawings.

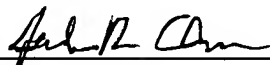
If the examiner maintains the objection, the examiner is requested to specifically cite proper legal authority for the proposition that a figure showing both old and new elements, including an element that is a hybrid of old art and new art, must be labeled as "prior art." Absent such legal authority, Applicant must respectfully submit that there is no proper legal basis for the objection.

### **Specification**

The examiner again objects to the specification, suggesting that the description of Figures 1 & 8 should indicate that they show prior art. For the reasons outlined above with respect to the objection to the drawings, Applicant respectfully submits that such a description would be incorrect. Accordingly, Applicant requests withdrawal of the objection to the specification.

In view of the above, Applicant submits that all currently pending claims are in condition for allowance. However, if any additional issues remain, the Examiner is requested to telephone the undersigned so that they may be expeditiously resolved.

Respectfully submitted,  
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